

REMARKS

The Final Office Action mailed November 4, 2004, has been received and reviewed. Claims 17 through 27, 29 through 31, 33 through 41, and 49 through 53 are currently pending in the application. Claims 17 through 27, 29 through 31, 33 through 41, and 49 through 53 stand rejected. Applicants propose to amend claims 17, 18, 29, 33, and 36, to cancel claim 22, and respectfully request reconsideration of the application as proposed to be amended herein.

Information Disclosure Statements

Please note that Information Disclosure Statements were filed herein on July 28, 2000 and on or about November 1, 2000, and that no copies of the PTO-1449 forms were returned with the outstanding Office Action. Applicants respectfully request that the information cited on the PTO-1449 forms be made of record herein. For the sake of convenience, second copies of the July 28, 2000 and November 1, 2000, Information Disclosure Statements, PTO-1449 forms, and USPTO date-stamped postcards are enclosed herewith. It is respectfully requested that an initialed copy of the PTO-1449 evidencing consideration of the cited references be returned to the undersigned attorney.

35 U.S.C. § 102(b) Anticipation Rejections**Anticipation Rejection Based on U.S. Patent No. 4,376,118 to Daher et al.**

Claims 17 through 19, 24 through 27, 29 through 31, 33, 36, 52 and 53 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Daher et al. (U.S. Patent No. 4,376,118). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Daher et al. cannot anticipate any of independent claims 17, 18 or 36, as amended herein, since Daher et al. does not expressly or inherently disclose each and every element of these claims.

Claim 17 is directed to, *inter alia*, a formulation comprising at least one beneficial agent, wherein said beneficial agent is selected from the group consisting of a peptide, a protein, a nucleotide, a hormone, a virus, an antibody, or analogs, derivatives, or pharmaceutically acceptable salts thereof, and a non-aqueous, single-phase biocompatible vehicle comprising a solvent, a surfactant, and a polymer, wherein the solvent is lauryl acetate. Daher et al. does not identically disclose a “beneficial agent” as recited in claim 17. Daher et al. does not identically disclose the beneficial agent of claim 17, but rather Daher et al. is limited to the use of a “tetracycline antibiotic salt.” (See, Daher et al., Col. 1, lines 34-41 and claim 1).

Claim 17 further cannot be anticipated since Daher et al. does not disclose the combination of the aforementioned beneficial agents together with the solvent of claim 17. Claim 17 recites that “the solvent is lauryl lactate.” As stated in Daher et al., “[t]he nonaqueous solvent can be ethanol, methanol, isopropanol, butanol, N-methyl-2-pyrrolidone or acetone. Ethanol is the preferred solvent.” (Daher et al. at Col. 1, lines 51-53). Since Daher et al. does not identically disclose lauryl lactate as the solvent as recited in claim 17, claim 17 cannot be anticipated.

Claims 19, 24-27 and 29-31 are novel, at the very least, as depending from novel independent claim 17.

Independent claim 18 also cannot be anticipated since Daher et al. does not identically disclose each and every element of claim 18. Claim 18 is directed to a non-aqueous formulation comprising at least one beneficial agent suspended in a vehicle comprising a solvent, a surfactant, and a polymer, wherein the solvent is lauryl lactate. As is the case in claim 17, the beneficial agent is selected from the group consisting of a peptide, a protein, a nucleotide, a hormone, a virus, an antibody, or analogs, derivatives, or pharmaceutically acceptable salts thereof. As previously established herein, Daher et al. does not identically disclose the beneficial agent together with lauryl lactate as a solvent the beneficial agent, as recited in claim 18. (See, Specification, supra; see also Daher et al., supra). As Daher et al. does not identically disclose each and every element of claim 18, it cannot be anticipated.

Independent claim 33 cannot be anticipated since Daher et al. does does not identically disclose each and every element of claim 33. Claim 33 is directed to a method for preparing a formulation comprising, *inter alia*, at least one beneficial agent and a non-aqueous, single-phase

biocompatible vehicle comprising lauryl lactate as a solvent and a beneficial agent selected from the group consisting of a peptide, a protein, a nucleotide, a hormone, a virus, an antibody, or analogs, derivatives, or pharmaceutically acceptable salts thereof. As Daher et al. does not identically disclose each and every element of claim 33, it cannot be anticipated.

Daher et al. also cannot anticipate independent claim 36 since it does not identically disclose each and every element of claim 36. Daher et al. does not identically disclose a method of treating a subject comprising administering a therapeutically effective amount of a formulation comprising at least one beneficial agent, wherein said beneficial agent is selected from the group consisting of a peptide, a protein, a nucleotide, a hormone, a virus, an antibody, or analogs, derivatives, or pharmaceutically acceptable salts thereof, and a non-aqueous, single-phase biocompatible vehicle comprising a solvent, a surfactant, and a polymer, wherein the solvent is lauryl lactate. As previously established herein, Daher et al. does not identically disclose a formulation having lauryl lactate as a solvent or the beneficial agents recited in amended claim 36. (See, Specification, supra; see also Daher et al., supra).

Claims 19, 24-27, 29-31, 33, 52 and 53 are not anticipated, at the very least, as depending directly or indirectly from amended independent claims 17 and 36.

Reconsideration and withdrawal of the anticipation rejections of claims 17-19, 24-27, 29-31, 33, 36, 52, and 53 are requested.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 4,376,118 to Daher et al.

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daher et al. (U.S. Patent No. 4,376,118). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.**

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

"If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." (See, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Thus, claims 20 and 21 are nonobvious, at the very least, as depending from novel independent claim 17. Further, Daher et al. does not, alone or modified, teach or suggest each and every element of claim 20 or 21 as required to establish a *prima facie* case of obviousness. For instance, as claims 20 and 21 depend from claim 17 and Daher et al. does not teach or suggest each and every element of the formulation of claim 17 (*i.e.*, "a beneficial agent" as recited in claim 17 together with lauryl lactate as a solvent for such a beneficial agent), a modification of Daher et al. also does not teach or suggest each and every element of claims 20 and 21.

Reconsideration and withdrawal of the obviousness rejections of claims 20 and 21 are requested.

Obviousness Rejection Based on U.S. Patent No. 4,376,118 to Daher et al.

Claims 34, 35, 40, 41 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daher et al. (U.S. Patent No. 4,376,118). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 34 and 35 are nonobvious, at the very least, as depending from nonobvious independent claim 33. Claims 40 and 41 are nonobvious, at the very least, as depending from nonobvious independent claim 36. Claim 49 is nonobvious, at the very least, as depending from nonobvious independent claim 17. Further, Daher et al. does not, alone or modified, teach or suggest each and every element of claims 34, 35, 40, 41 or 49 as required to establish a *prima facie* case of obviousness. For instance, as claims 34, 35, 40, 41, and 49 either directly or indirectly depend from claims 17, 33, or 36, and Daher et al. does not teach or suggest each and every element of these claims (*i.e.*, "a beneficial agent", use thereof or method of making the same, as recited in the claims together with lauryl lactate as a solvent), a modification of Daher et al. also does not teach or suggest each and every element of claims 34, 35, 40, 41 or 49.

Reconsideration and withdrawal of the obviousness rejections of claims 34, 35, 40, 41 and 49 are requested.

Obviousness Rejection Based on U.S. Patent No. 4,376,118 to Daher et al. in view of U.S. Patent No. 5,290,271 to Jernberg

Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Daher et al. (U.S. Patent No. 4,376,118) in view of Jernberg (U.S. Patent No. 5,290,271). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 39 is nonobvious, at the very least, as depending from nonobvious claim 36. Further, Daher et al. does not alone or in combination with Jernberg teach or suggest each and every element of claim 39 as required to establish a *prima facie* case of obviousness. For instance, as claim 39 depends from claim 36 and Daher et al. does not teach or suggest each and every element of the method of claim 36 (*i.e.*, use of “a beneficial agent” as recited therein together with lauryl lactate as a solvent), a resultant combination of Jernberg with Daher et al. also does not teach or suggest each and every element of claim 39.

Reconsideration and withdrawal of the obviousness rejection of claim 39 are requested.

Obviousness Rejection Based on U.S. Patent No. 4,376,118 to Daher et al. in view of GB 1,049,104

Claims 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daher et al. (U.S. Patent No. 4,376,118) in view of GB 1,049,104. Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 37 and 38 are nonobvious, at the very least, as depending from nonobvious independent claim 36. Further, Daher et al. does not alone or in combination with GB 1,049,104 teach or suggest each and every element of claims 37 and 38 as required to establish a *prima facie* case of obviousness. For instance, as claims 37 and 38 depend from claim 36 and Daher et al. does not teach or suggest the each and every element of the method of claim 36 (*i.e.*, use of “a beneficial agent” as recited therein together with lauryl lactate as a solvent), a resultant combination of GB 1,049,104 with Daher et al. also does not teach or suggest each and every element of claims 37 and 38.

Reconsideration and withdrawal of the obviousness rejections of claims 37 and 38 are requested.

Obviousness Rejection Based on U.S. Patent No. 4,376,118 to Daher et al. in view of U.S. Patent No. 3,632,768 to Bergy et al.

Claims 50 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daher et al. (U.S. Patent No. 4,376,118) in view of Bergy et al. (U.S. Patent No. 3,632,768). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 50 and 51 are nonobvious, at the very least, as depending from nonobvious independent claims 17. (*See, Id.*). Further, Daher et al. does not alone or in combination with Bergy et al. teach or suggest each and every element of claims 50 and 51 as required to establish a *prima facie* case of obviousness. For instance, as claims 50 and 51 depend from claim 17 and Daher et al. does not teach or suggest each and every element of the formulation of claim 17 (*i.e.*, “a beneficial agent” as recited thereing in combination with lauryl lactate as a solvent), a resultant combination of Bergy et al. with Daher et al. also does not teach or suggest each and every element of claims 50 and 51.

Reconsideration and withdrawal of the obviousness rejections of claims 50 and 51 are requested.

Obviousness Rejection Based on U.S. Patent No. 4,376,118 to Daher et al. in view of U.S. Patent No. 5,284,655 to Bogdanský et al.

Claims 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daher et al. (U.S. Patent No. 4,376,118) in view of Bogdanský et al. (U.S. Patent No. 5,284,655). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 22 and 23 are nonobvious, at the very least, as depending from nonobvious independent claim 22. (*See, Id.*).

The 35 U.S.C. § 103(a) obviousness rejections of claims 22 and 23 are improper because a *prima facie* case of obviousness cannot be established since Daher et al. does not alone, or in combination with Bogdanský, teach or suggest each and every element of claim 22 or 23 as required for obviousness. For instance, as previously established herein, Daher et al. does not

disclose the a formulation comprising the beneficial agents recited in claim 17 together with lauryl lactate as a solvent, and Bogdanský does not remedy the deficiency of Daher et al. in this regard.

With further regard to dependent claims 22 and 23, no suggestion or motivation exists to combine Daher et al. with Bogdanský. The Office Action indicated that “protein and tetracycline are equivalent as active agents in Bogdanský. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the tetracycline formulation of Daher. One would have been motivated to substitute protein for tetracycline with the expectation that the protein containing formulation will be flowable and suitable for implantation.” (Office Action at page 6).

However, Bogdanský does not indicate that protein and tetracycline are equivalent as active agents as asserted in the Office Action. Bogdanský merely indicates that “medically/surgically useful substances which can be readily incorporated in the osteogenic composition include [a laundry list of compounds]...” (Bogdanský, Col. 5, lines 47-49). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (M.P.E.P. § 2143.01 *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original)). Since Daher et al. does not suggest or motivate the use of a peptide and Bogdanský does not suggest or motivate the use of a stable nonaqueous solution including a nonaqueous diluent, nonaqueous solvent and nonaqueous nonionic solubilizer and is limited to a flowable osteogenic composition, no suggestion or motivation exists to combine Daher et al. with Bogdanský. Thus, a *prima facie* case of obviousness cannot be established with regard to claims 22 and 23.

Reconsideration and withdrawal of the obviousness rejections of claims 22 and 23 are requested.

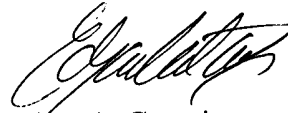
ENTRY OF AMENDMENTS

The proposed amendments to claims 17, 18, 29, 33, and 36 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 17-21, 23-27, 29-31, 33-41 and 49-53 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



Edgar R. Cataxinos
Registration No. 39,931
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: January 4, 2005

ERC/dlm:dn

Document in ProLaw